



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,904	07/16/2003	Joseph L. Tallal JR.	GM2:1003	8957
34725	7590	08/03/2007	EXAMINER	
CHALKER FLORES, LLP			RAPILLO, KRISTINE K	
2711 LBJ FRWY			ART UNIT	
Suite 1036			PAPER NUMBER	
DALLAS, TX 75234			3609	
			MAIL DATE	DELIVERY MODE
			08/03/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/620,904	Applicant(s) TALLAL, JOSEPH L.	
	Examiner Kristine K. Rapillo	Art Unit 3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1 – 28 are pending.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 1 - 110 (Copay) and Figure 11C – 1180 (Insurance company pays provider for good or services provided above deductible). Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Figure 4 – 318 (Premium listings) and Figure 9C – 804 (Pharmacy benefit manager). The examiner interprets the reference number 318 in Figure 4 to be a typographical error; reference number 308 refers to 'premium listing' in the specification for Figure 4.
3. The drawings are objected to because of an error in the numbering of the reference numbers. In Figure 11A, reference number 1110 is defined as "Receive advertising fees from third parties", however, in the specification reference number 1110 is defined as "Received membership fees from new and renewing members". The reverse is true for reference number 1116 – it is defined as "Received membership fees

Art Unit: 3609

from new and renewing members” in Figure 11A, but is defined as Receive advertising fees from third parties” in the specification.

4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the reference characters listed below have been used to designate the same description in the specification

- 672 and 1172 – Contact select provider
- 110 and 256 – Copay
- 212, 712, 812, and 1008 – Discount price
- 104 and 202 – Individuals
- 102, 252, and 1002 – Insurance company
- 634 and 1132 – Join member provider network
- 258 and 1010 – Major medical payment
- 208 and 1012 – Medical service/good provider listing and discount price list
- 206, 302, 418, 420, 422, 424, and 426 – Medical service/good providers
- 202, 402, 408, 410, 412, 414, and 416 – Members
- 504, 710, 810, and 1006 – Network provider
- 664, 962, and 1162 – Pay membership fee to join member-provider network
- 644, 936, and 1142 – Pay premium listing fee
- 108 and 254 – Premium
- 308 and 932 – Premium listing
- 642 and 1140 – Provide basic listing information
- 614, 908, and 1120 – Provide basic/premium listings and price lists to members

Art Unit: 3609

- 648 and 1146 – Provide goods or services to members
- 938 and 1144 – Provide premium listing information
- 610 and 1110 – Receive advertising fees
- 674 and 1174 – Receive goods or services from provider
- 604, 902, and 1116 – Receive membership fees from new and renewing members
- 650 and 1150 – Receive payment for goods or services
- 666 and 1166 – Search provider list by area
- 668 and 1168 – Select provider and review provider listing
- 638 and 1136 – Submit price list
- 618, 916, and 1124 – Update information provided to members

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character 202 has been used to designate both Individuals and Members.

6. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of

Art Unit: 3609

any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Art Unit: 3609

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1 – 7, 10 – 18, 21 – 23, and 26 - 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 - 22 of copending Application No. 10/620,903 (Tallal). This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations from the claims of U.S. Application No. 10/620,904 are covered in the claims of U.S. Application No. 10/620,903.

9. The table below is a comparison of all obvious-type double patenting claims. The differences between the claims have been bolded and a summary of the rejection is included in the row directly below the affected claims.

Application 10/620,904	Reference: Application 10/620,903
<p>1. A system comprising:</p> <p>a network provider that provides a health care plan;</p> <p>one or more medical service/good providers that have joined the health care plan;</p> <p>one or more individuals that are members of the health care plan;</p> <p>and a discount price list provided by the network provider that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list.</p>	<p>1. A system comprising:</p> <p>a pharmacy benefit manager that provides a pharmaceutical benefit program;</p> <p>one or more individuals that are members of the pharmaceutical benefit program;</p> <p>and a discount price list provided by the pharmacy benefit manager that regulates the cost of pharmaceuticals provided to the members by the pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>

Art Unit: 3609

<p>Regarding claim 1:</p> <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager. Each function assumes the responsibility to oversee a health care plan. • A pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which are generated from a medical service visit). • The term pharmaceuticals is encompassed by the generic term of services/goods, in that pharmaceuticals can be 'services/goods'. <p>Therefore, claim 1 of this application is not patentably distinct from application 10/620,903:</p>		
2. The system as recited in claim 1, wherein the discount price list is a variable discount price list that tracks a known standard service price list.		2. The system as recited in claim 1, wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list.
<p>Regarding claim 2, the standard service price list and the standard pharmaceutical price list serve the same function in that they both track a standard price list, therefore, claim 2 of this application is not patentably distinct from claim 2 of the reference application.</p>		
3. The system as recited in claim 1, wherein the individuals pay a membership fee to the network provider to join the health care plan .		3. The system as recited in claim 1, wherein the individuals pay a membership fee to the pharmacy benefit manager to join the pharmaceutical benefit program .
<p>Regarding claim 3, a network provider is providing the same function as a pharmacy benefit manager. Each function assumes the responsibility to oversee a health care plan, in which the network provider and pharmacy benefit manager are the recipients of the membership fees used join the health care plan or pharmaceutical benefit program. Therefore, claim 3 of this application is not patentably distinct from claim 3 of the reference application.</p>		
4. The system as recited in claim 3, wherein the membership fee is paid by the individual's employer.		4. The system as recited in claim 3, wherein the membership fee is paid by the individual's employer.
<p>Regarding claim 4: Claim 4 is not patentably distinct from claim 4 of the reference application, therefore, claim 4 is obvious.</p>		
5. The system as recited in claim 3, wherein the membership fee is paid by the individual's business.		5. The system as recited in claim 3, wherein the membership fee is paid by the individual's business.
<p>Regarding claim 5: Claim 5 is not patentably distinct from claim 5 of the reference application, therefore, claim 5 is obvious.</p>		

Art Unit: 3609

6. The system as recited in claim 3, wherein the membership fee is a renewal fee.	6. The system as recited in claim 3, wherein the membership fee is a renewal fee.
Regarding claim 6: Claim 6 is not patentably distinct from claim 6 of the reference application, therefore, claim 6 is obvious.	
7. The system as recited in claim 1, wherein the member includes his/her family in the health care plan .	7. The system as recited in claim 1, wherein the member includes his/her family in the pharmaceutical benefit program .
Regarding claim 7, a pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which are generated from a medical service visit). Therefore, claim 7 is obvious.	
10. The system as recited in claim 1, further comprising a medical service/good provider listing provided by the network provider to the members.	8. The system as recited in claim 1, further comprising a pharmaceutical listing provided by the pharmacy benefit manager to the members.
Regarding claim 10: <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager. Each function assumes the responsibility to oversee a health care plan • A medical service/good provider listing is equivalent to a pharmaceutical listing in that each are a listing of all physicians and medications within a health care plan. Therefore, claim 10 is not patentably distinct from claim 8 of the reference application, therefore, claim 10 is obvious.	
11. The system as recited in claim 10, wherein the medical service/good provider listing comprises basic listings and premium listings.	9. The system as recited in claim 8, wherein the pharmaceutical listing comprises basic listings and premium listings.
Regarding claim 11: Claim 11 is not patentably distinct from claim 9 of the reference application, therefore, claim 11 is obvious.	
12. The system as recited in claim 11, wherein the basic listings are provided to medical service/good providers free of charge.	10. The system as recited in claim 9, wherein the basic listings are provided to pharmaceutical companies free of charge.
Regarding claim 12: Claim 12 is not patentably distinct from claim 10 of the reference application, therefore, claim 12 is obvious.	

Art Unit: 3609

13. The system as recited in,claim 11, wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee.	11. The system as recited in claim 9, wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee.
Regarding claim 13: Claim 13 is not patentably distinct from claim 11 of the reference application, therefore, claim 13 is obvious.	
14. The system as recited in claim 13, wherein the premium listings include a link to a customizable web page for the medical service/good providers that is accessible via a global telecommunications network.	12. The system as recited in claim 9, wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network.
Regarding claim 14: Claim 14 is not patentably distinct from claim 12 of the reference application. Claim 14 of the application refers to a web page for a medical service/good provider whereas claim 12 of the reference refers to a web page for a pharmaceutical company. The same system can be used for the pharmaceutical company and medical service/good provider therefore claim 14 is obvious.	
15. The system as recited in claim 13, wherein the premium listings include a link to the medical service/good provider's web site.	13. The system as recited in claim 9, wherein the premium listings include a link to the pharmaceutical company's web site.
Regarding claim 15: Claim 15 is not patentably distinct from claim 13 of the reference application therefore claim 15 is obvious.	
16. The system as recited in claim 13, wherein the premium listings are customized for each medical service/good provider.	14. The system as recited in claim 9, wherein the premium listings are customized for each pharmaceutical company.
Regarding claim 16: Claim 16 is not patentably distinct from claim 14 of the reference application therefore claim 16 is obvious.	
17. The system as recited in claim 10, wherein the discount price list and the medical service/good provider listing is accessible via a global telecommunications network.	15. The system as recited in claim 8, wherein the discount price list and the pharmaceutical listing is accessible via a global telecommunications network.
Regarding claim 17: Claim 17 is not patentably distinct from claim 15 of the reference application therefore claim 17 is obvious.	

Art Unit: 3609

18. The system as recited in claim 10, wherein the discount price list and the medical service/good provider listing are searchable by the members using one or more search criteria.	16. The system as recited in claim 8, wherein the discount price list and the pharmaceutical listing are searchable by the members using one or more search criteria.
Regarding claim 18: Claim 18 is not patentably distinct from claim 16 of the reference application therefore claim 18 is obvious.	
21. The system as recited in claim 1, further comprising one or more advertisements provided by the network provider to the members.	17. The system as recited in claim 1, further comprising one or more advertisements provided by the pharmacy benefit manager to the members.
Regarding claim 21, a network provider is providing the same function as a pharmacy benefit manager, as per claim 1. Therefore, claim 21 of this application is not patentably distinct from claim 17 of the reference application.	
22. The system as recited in claim 21, wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members.	18. The system as recited in claim 17, wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members.
Regarding claim 22, a network provider is providing the same function as a pharmacy benefit manager, as per claim 1. Therefore, claim 18 of this application is not patentably distinct from claim 22 of the reference application.	
23. The system as recited in claim 21, wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing.	19. The system as recited in claim 18, wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing.
Regarding claim 23: Claim 23 is not patentably distinct from claim 19 of the reference application therefore claim 23 is obvious.	
26. A method for providing a health care plan comprising the steps of: receiving a membership fee from one or more	20. A method for providing a pharmaceutical benefit program comprising the steps of:

Art Unit: 3609

<p>individuals to become members of the health care plan;</p> <p>obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list.</p>	<p>receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program; and</p> <p>providing a discount price list that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>
<p>Regarding claim 26:</p> <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager, as per claim 1. • The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1. <p>Therefore, claim 26 of this application is not patentably distinct from claim 20 of the reference application.</p>	
<p>27. A computer program embodied on a computer readable medium for providing a health care plan comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the health care plan;</p> <p>a code segment for obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>a code segment for providing a discount price list that regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered based on the discount price list.</p>	<p>21. A method for providing a pharmaceutical benefit program comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program; and</p> <p>providing a discount price list that regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided based on the discount price list.</p>

Art Unit: 3609

Regarding claim 27:

- A network provider is providing the same function as a pharmacy benefit manager, as per claim 1.
- The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1.

Therefore, claim 27 of this application is not patentably distinct from claim 21 of application 10/620,903.

28. An apparatus for providing a **health care plan** comprising:
a server;
one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates the cost of services/goods provided to a member of the **health care plan** by a medical service/good provider such that the member pays the medical service/good provider in-full directly for any **services/goods** rendered based on the discount price list;

a communications interface communicably coupled to the server that allows a member to access the discount price list; and

wherein the member is an individual that has paid a membership fee to join the **health care plan**.

22. An apparatus for providing a **pharmaceutical benefit program** comprising:

a server,

one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list that regulates cost of **pharmaceuticals** provided to the members by a **pharmacy benefit manager** such that the members pay the **pharmacy benefit manager** in-full directly for any **pharmaceuticals** provided based on the discount price list;

a communications interface communicably coupled to the server that allows a member to access the discount price list; and

wherein the member is an individual that has paid a membership fee to join the **pharmaceutical benefit program**.

Regarding claim 28:

- A network provider is providing the same function as a pharmacy benefit manager, as per claim 1.
- The term pharmaceuticals is encompassed by the generic term of services/goods, as per claim 1.

Therefore, claim 28 of this application is not patentably distinct from claim 22 of application 10/620,903.

Claim Rejections - 35 USC § 101

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention encompasses a human being, therefore it is directed to nonstatutory subject matter. The examiner interprets the medical service/good providers that have joined the health plan to be human beings under the broadest reasonable interpretation of the claimed invention.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1 – 10 and 24 - 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée

(<http://web.archive.org/web/20011130030647/http://carentree.com>, 2001) in view of

Lipton, et al ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, page 361).

As per claim 1, Care Entrée teaches a network provider that provides a health care plan (page 5, paragraphs 21 - 23), one or more medical service/good providers that have joined the health care plan (page 3, paragraph 11 and page 4, paragraphs 14 - 15), one or more individuals that are members of the health care plan (page 2, paragraph 5), and a system in which the members pay the medical services/good provider directly (page 2, paragraph 3).

The Care Entrée program does not explicitly teach a system of providing discount price lists to members.

Lipton et al. teaches a system comprising a discount price list provided by the network provider, which regulates the cost of services/goods provided to the members (paragraph 30). The examiner interprets the pharmacy benefit manager to be a similar function as the network provider in that it provides a discount on all health care needs.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a discount price list regulating the cost of services/goods in which the member pays the network provider directly as taught by Lipton et al. with the motivation of controlling medical services/good provider costs via negotiated discounts (paragraph 7). Lipton et al. discusses formulary development, which leads to a list of preferred medications in which a pharmacy benefit manager has acquired a discounted price. This can be equated to a preferred provider discount list in which a health care plan has acquired a discount price on medical services provided.

As per claim 2, the Care Entrée program fails to teach a system as per claim 1.

Art Unit: 3609

Lipton et al. teaches a system in which the discount price list is a variable discount price list that tracks a known standard service price list (paragraph 7). This is accomplished through the use of negotiated discounts with pharmacy networks, as well as controlling the formularies used by the pharmacy benefit manager (i.e. the pharmacy benefit manager chooses which drugs to include in the formulary, thereby lowering the cost of the pharmaceuticals). This same method can be applied to a list of services provided by a medical provider, wherein negotiated discounts are applied to medical providers, hospitals, hearing, vision, etc. It can be assumed that lists are required to provide network provider with the recent price list, as well as the discounted price list.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system in which a discount price list tracks a known service price list as taught by Lipton et al. with the motivation of managing medical costs and services (paragraphs 32 – 34). This is accomplished by a pharmacy benefit manager via drug enrollments reports/physician prescription history and rebates from the drug manufacturer. This can be equated to a network provider in that the network provider takes the information and generates data pertaining to which medical services are most frequently prescribed or ordered, and uses this information to negotiate a discount on that particular service and/or medication.

As per claim 3, the Care Entrée program teaches a system in which individuals pay a membership fee to the network provider to join the health care plan (page 3,

paragraph 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

As per claim 4, the Care Entrée program teaches a system in which the membership fee is paid by the individual's employer (page 12, paragraph 67).

As per claim 5, the Care Entrée program teaches a system in which the membership fee is paid by the individual's business (page 12, paragraph 67). The examiner interprets an individual's employer, in this case, to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

As per claim 6, the Care Entrée program teaches a system wherein the membership fee is a renewal fee (page 2, paragraph 6). The examiner interprets the monthly fee to be a renewal fee – the member is paying a renewal fee every month.

As per claim 7, the Care Entrée program teaches a system wherein the member can include his/her family in the health care plan (page 3, paragraph 10). The Care Entrée program allows the entire family (including all Internal Revenue Service dependents) to join the health care plan.

Art Unit: 3609

As per claim 8, the Care Entrée program teaches a system wherein the medical service/good providers are selected from the group consisting of physicians, hospitals, physical therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers (page 11, paragraphs 61 – 63). Although physical therapy, cancer treatment centers, and medical, hospital, and handicap supply stores are not specifically taught in the Care Entrée program, these services/providers can be included as ancillary services, as taught by the Care Entrée program (page 5, paragraphs 21 – 23).

As per claim 9, the Care Entrée program teaches a system wherein the medical service/good provider is a doctor that works for a corporation (page 4, paragraph 16). The Care Entrée program refers to this as a PHCS (Private Health Care System).

As per claim 10, the Care Entrée program teaches a system comprising a medical service/good provider listing provided by the network provider to the members (page 12, paragraphs 68 and 69). The Care Entrée program provides a listing of common health care providers in certain area.

As per claim 24, the Care Entrée program teaches a system wherein the network provider is an insurance provider (page 8, paragraph 36). A PPO is defined as a preferred provider organization.

As per claim 25, the Care Entrée program teaches a system wherein the insurance provider provides members with major medical insurance in return for payment of one or more major medical premiums (page 2, paragraph 5).

As per claim 26, the Care Entrée program teaches a method for receiving a membership fee from one or more individuals to become members of the health care plan (page 3, paragraph 10). Individuals, as well as family members and/or other dependents, may pay a monthly fee in order to become a member of a supplemental health care plan. The Care Entrée program also teaches a method for obtaining information from one or more medical service/good providers that have joined the health care plan (page 8, paragraph 41) and a system in which the members pay the medical services/good provider directly (page 2, paragraph 3).

The Care Entrée program does not teach a method to provide a discount price list regulating the cost of services/goods provided.

Lipton et al. teaches a system comprising a discount price list provided by the network provide, which regulates the cost of services/goods provided to the members (paragraph 30). The examiner interprets the pharmacy benefit manager to be a similar function as the network provider in that it provides a discount on all health care needs.

The motivation for combining the teachings of the Care Entrée Program and Lipton et al. is discussed in claim 2.

Art Unit: 3609

13. Claims 11 – 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (www.careentree.com) in view of Lipton et al. as applied to claim 1 above, and further in view of U.S. Patent No. 5,819,092 (Ferguson, et al.).

As per claim 11, the system of claim 10 as applied to claim 1, is taught by the Care Entrée program, in view of Lipton et al.

The Care Entrée program and Lipton et al. do not teach a system comprising basic and premium listings.

Ferguson et al. teaches a system wherein the medical service/good provider listing comprises basic listings and premium listings (column 7, lines 10 – 18 and column 13, lines 66 – 67 through column 14, lines 1 – 6). The examiner interprets basic and premium listings to be equivalent to a directory lookup service, as disclosed in Ferguson et al. The directory look up service can encompass a listing of people (i.e. physicians) and products (i.e. pharmaceuticals).

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of basic and premium listings as taught by Ferguson et al. with the motivation of providing a fast method of online searching directories (column 4, lines 18 – 20 and 41 – 43).

As per claim 12, the system of claim 11 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

Art Unit: 3609

The Care Entrée program and Lipton et al. fail to teach a system wherein the basic listings are free of charge to medical services/good providers.

Ferguson et al. teaches a system wherein the basic listings are provided to medical service/good providers free of charge (column 13, lines 66 – 67 through column 14, lines 1 – 12). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'basic' listing – where a name, address and other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 11.

As per claim 13, the system of claim 11 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the premium listings are available to medical service/good providers for a fee.

Ferguson et al. teaches a system wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee (column 14, lines 6 – 12 and column 18, lines 33 - 35). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'premium' listing – where a name, address and a hyperlinked document with other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claim 11.

As per claims 14, 15, and 16 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the premium listings are hyperlinked to a medical service/good providers web page.

Ferguson et al. teaches a system wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network, wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical service/good provider (column 14, lines 6 – 19 and column 7, lines 37 - 42). The hyperlinks allow the user to access a site in which qualified users may submit new entries, thereby making it customizable.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of premium listings hyperlinked to a medical service/good providers web page (where the medical service/good provider can be equated to a pharmaceutical company) and is accessible to the global internet as taught by Ferguson et al. with the motivation of allowing a user to create online services using existing information (column 7, lines 1 – 4).

As per claim 17, the system of claim 10 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the discount price list is available via a telecommunications network.

Art Unit: 3609

Ferguson et al. teaches a system wherein the discount price list and the medical service/good providers listing are accessible via a global telecommunications network (column 14, lines 2 – 6 and column 7, lines 37 - 42). The examiner interprets the discount price list to be a function of the directory look up disclosed by Ferguson et al. It provides information to users of a health care plan.

The motivation for combining the teachings of the Care Entrée Program, Lipton et al., and Ferguson et al. is discussed in claims 14, 15, and 16.

As per claim 18, the system of claim 10 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the discount price list is searchable by members of the health care plan.

Ferguson et al. teaches a system wherein the discount price list and the medical service/goods providers listing are searchable by the members using one or more search criteria (column 10, lines 62-65). Ferguson et al. discloses a method where users are allowed to perform searches, where they can specify the search criteria.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of searching a discount price list and medical service/goods providers listings as taught by Ferguson et al. with the motivation of enabling users to search listings or entries in a directory by a variety of techniques (column 14, lines 10 – 12), including names, categories, and full text searches.

Art Unit: 3609

As per claims 19 and 20, the Care Entrée program teaches a system wherein one of the search criteria is based on geographic area and one of the search criteria is based on the services provided by the medical service/good provider (page 12, paragraphs 68 and 69). The Care Entrée program provides a listing of common health care providers in certain area.

As per claim 21, the Care Entrée program in view of Lipton et al teaches the system of claim 1.

The Care Entrée program and Lipton et al. fail to explicitly teach a system wherein the network provider provides the advertisements to members.

Ferguson et al. teaches a system comprising one or more advertisements provided by the network provider to the members (column 14, lines 6 – 12 and column 14, lines 21 – 31). Ferguson et al. discloses a method of online classified advertisements, which are available using hyperlinked documents.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of placing online advertisements as taught by Ferguson et al. with the motivation of increasing the sales of a medical services/goods provider by use of advertisements in the discount price list provided by the network provider (column 9, lines 54 – 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would advertise services of medical professionals, hospitals and more.

Art Unit: 3609

As per claim 22, the system of claim 21 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the advertiser pays the network provider a fee for advertising.

Ferguson et al. teaches a system wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members (column 18, lines 33 – 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of charging a fee to place advertisements as taught by Ferguson et al. with the motivation of creating an easy to use online service (column 10, lines 25 – 29) which can be used to generate revenue for a network provider by allowing a medical service/good provider to advertise on medical services/goods provider lists.

As per claim 23, the system of claim 21 as applied to claim 1, is taught by the Care Entrée program in view of Lipton et al.

The Care Entrée program and Lipton et al. fail to teach a system wherein the advertisement is used to search the medical service/good provider listing.

Ferguson et al. teaches a system wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing (column 14, lines 6 - 12). Searches can be made in directory look up's using names, categories or full text search techniques.

Art Unit: 3609

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a system of including advertisements when conducting a search of a medical service/good provider listing as taught by Ferguson et al. with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30 – 31).

14. Claims 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (www.careentree.com) in view of U.S. Patent No. 5,819,092 (Ferguson, et al.).

As per claim 27, the Care Entrée program teaches a health care plan.

The Care Entrée program fails to disclose a system in which a computer program is embodied on a computer readable medium, including code segments for receiving membership fees from individuals and providing discount price lists to members, in which the members pay the network provider directly.

Ferguson et al. teaches a system in which a code segment for receiving a membership fee from one or more individuals to become members of the health care plan (column 35, lines 24 – 28), a code segment for obtaining information from one or more medical service/good providers that have joined the health plan (column 35, lines 34 – 28 and column 36, lines 14 – 17), and a code segment for providing a discount price list that regulates the cost of goods/services to members in which the members pay the network provider the discounted price directly (column 31, lines 26 – 31).

Art Unit: 3609

Ferguson et al. discloses a code segment in which a program defines the fees to be paid to the entity (which in this case is the network provider). Ferguson et al. also discloses a code segment in which a 'yellow pages' style online service is generated. The examiner interprets this to mean that a code segment was used in order to generate a 'yellow pages' style online service.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include code segments to provide a means of receiving membership fees and to provide a discount price list as taught by Ferguson et al. with the motivation of creating an online service to develop a fee structure for membership fees as well as contribute to the generation of a discount price list (column 4, lines 51 – 60).

As per claim 28, the Care Entrée program teaches a system in which individuals pay a membership fee to the network provider to join the health care plan (page 3, paragraph 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

The Care Entrée program fails to disclose an apparatus for providing a health care plan including a server, storage devices, communication interface, and a membership fee.

Ferguson et al. teaches a system for providing a health care plan comprising a server (column 7, lines 42 – 47); one or more storage devices communicable coupled to the server, the one or more storage devices containing a discount price list that

Art Unit: 3609

regulates the cost of goods/services provided to the members by a health care plan such that the members pay the network provider for any goods and/or services provided in full directly the discount price (column 7, lines 64 – 66); and a communications interface communicably coupled to the server that allows a member to access the discount price list (column 7, lines 48 – 50).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a server, storage devices, and a communication interface as taught by Ferguson et al. with the motivation of creating a computer platform, where the hardware is independent, thus allowing the software to be implemented on several different computer architectures (column 7, lines 33 – 35).

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goch ("A new card deal", Best's Review. Oldwick: July 2002. Vol. 103, Iss. 3; page 73) is cited for relevance for its description of non-insurance health care programs which offer discounted physicians visits and prescription costs. Sawada ("Mainland-based medical plan grows despite state eye", Pacific Business News. Honolulu: June 21, 2002. Vol. 40, Iss. 15; page 23) is cited for relevance for its summary of the Care Entrée program. Babula ("Health care clubs option to insurance", Las Vegas Review – Journal. Las Vegas, Nev.: Nov. 17, 2001. Page 1.B) is cited for relevance in regards to its review of non-insurance health care, including membership.

Art Unit: 3609

fees and discounted rates for physician visits/pharmaceuticals. The following websites have been cited for relevance: www.allianceMD.com, 2001; www.addhealth.com, 2001; and www.procarecard.com, 2001. The previously mentioned websites are non-insurance health plans and provide brief descriptions of the services available.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristine K. Rapillo whose telephone number is 571-270-3225. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Akm Ullah can be reached on 571-272-2361. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


AKM ULLAH
SUPERVISORY PATENT EXAMINER

Application/Control Number: 10/620,904

Page 29

Art Unit: 3609

KKR